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In re Application of : MAR 1 2 2004
Esin Cubukcu, Steve Dahar, Ravi Dodeja, :
Arnold Z. Gordon, Daniel Kalynchuk, Troy :
Shanon Prince, Justin Soltesz, Mike Waite, :
and Sandeep Chawla :
Application No. 10/612,330 : DECISION ON PETITION
Filed: July 2, 2003 :
Attorney Docket No. 21980-04012 :
Title: CERAMIC COMPOSITE :
ELECTROLYTIC DEVICE :

This is in response to the petition under 37 C.F.R. §1.47(a)¹, filed November 21, 2003.

On July 2, 2003, the application was deposited, identifying Esin Cubukcu, Steve Dahar, Ravi Dodeja, Arnold Z. Gordon, Daniel Kalynchuk, Troy Shanon Prince, Justin Soltesz, Mike Waite, and Sandeep Chawla as joint inventors. The application was deposited without a fully executed oath or declaration². On September 30, 2003, the Office mailed a Notice to File Missing Parts of Nonprovisional Application (Notice), requiring an executed oath or declaration along with the surcharge associated with the late filing of an

¹A grantable petition under 37 C.F.R. §1.47(a) requires:

- (1) the petition fee of \$130;
- (2) a surcharge of either \$65 or \$130 if the petition is not filed at the time of filing the application, as set forth in 37 CFR § 1.16(e);
- (3) a statement of the last known address of the non-signing inventors;
- (4) either
 - a) proof that a copy of the entire application (specification, claims, drawings, and the oath or declaration) was sent or given to the non-signing inventor for review and proof that the non-signing inventor refuses to join in the application or
 - b) proof that the non-signing inventor cannot be found or reached after diligent effort;
- (5) a declaration which complies with 37 CFR §1.63.

² Joint inventor Prince did not execute the declaration.

oath or declaration. The notice set a two-month period for response, and indicated that the basic filing fee and replacement drawings were required.

The instant application is a divisional of parent application 09/020,204, which issued as patent number 6074771 on June 13, 2000. On November 5, 1998, petitioner filed a petition under 37 C.F.R. §1.47(a) to accept the declaration without the signature of joint inventor Prince. On October 8, 1999, a decision was mailed which accorded Rule 47(a) status to application number 09/020,204.

On November 21, petitioner submitted a copy of the declaration³, the instant petition, a statement of facts, the basic filing fee, the petition fee (charged to Petitioner's Deposit Account, as authorized in the petition), a copy of the 1.47(a) petition filed with the parent application (09/020,204), copies of letters and an assignment agreement, and a copy of the decision mailed October 8, 1999.

On December 22, 2003, the Office withdrew the notice mailed September 30, 2003, and mailed a corrected notice, which set forth that all signatures were missing from the declaration, and that substitute drawings were required. The corrected notice restarted the two-month period for response.

Petitioner should note that although she filed a petition under 37 CFR §1.47(a) on November 21, 2003, she was not relieved of the requirement to submit a timely reply to the Notice to File Missing Parts of Application⁴. Both the notice and the corrected notice set forth that substitute drawings were required. To date, these have not been supplied.

37 C.F.R. 1.63(d)(3) sets forth:

- (3) Where the executed oath or declaration of which a copy is submitted for a continuation or divisional application was originally filed in a prior application accorded status under 37 C.F.R. §1.47, the copy of the executed oath or declaration for such prior application must be accompanied by:
 - (i) A copy of the decision granting a petition to accord 37 C.F.R. §1.47 status to the prior application, unless all inventors or legal representatives have filed an oath or declaration to join in an application accorded status under 37 C.F.R. §1.47 of which the continuation or divisional application claims a benefit under 35 U.S.C. §§120, 121, or 365(c); and
 - (ii) If one or more inventor(s) or legal representative(s) who refused to join in the prior application or could not be found or reached has subsequently joined in the prior application or another application of which the continuation or divisional application claims a benefit under 35 U.S.C. §§120, 121, or 365(c), a copy of the subsequently executed oath(s) or declaration(s) filed by the inventor or legal representative to join in the application.

MPEP 201.06(c) sets forth:

37 CFR 1.63(d)(3) provides for the situation in which the executed oath or declaration, of which a copy is submitted for a continuation or divisional application, was originally filed in a prior application accorded status under 37 CFR 1.47. 37 CFR 1.63(d)(3)(i) requires a copy of any decision granting a petition to accord 37 CFR 1.47 status to such application, unless all nonsigning inventor(s) or legal representative

³ Again, the declaration submitted with the instant petition was executed by each of the joint inventors save joint inventor Prince.

⁴ See 37 CFR §1.135(b).

(pursuant to 37 CFR 1.42 or 1.43) have filed an oath or declaration to join in an application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121 or 365(c). Where one or more, but not all, nonsigning inventor or legal representative (pursuant to 37 CFR 1.42 or 1.43) subsequently joins in any application of which the continuation or divisional application claims a benefit under 35 U.S.C. 120, 121 or 365(c), 37 CFR 1.63(d)(3)(ii) also requires a copy of any oath or declaration filed by the inventor or legal representative who subsequently joined in such application.

New continuation or divisional applications filed under 37 CFR 1.53(b) which contain a copy of an oath or declaration that is not signed by one of the inventors and a copy of the decision according 37 CFR 1.47 status in the prior application, should be forwarded by the Office of Initial Patent Examination (OIPE) to the Office of Petitions before being forwarded to the Technology Center (TC). The Office of Petitions will mail applicant a letter stating that "Rule 47" status has been accorded to the continuation or divisional application, but will not repeat the notice to the nonsigning inventor nor the announcement in the *Official Gazette*. See 37 CFR 1.47(c).

Petitioner has supplied copies of both the petition of November 5, 1998 and the decision of October 8, 1999.

As such, The above-identified application and papers have been reviewed and found in compliance with 37 CFR 1.47(a). This application is hereby accorded Rule 1.47(a) status.

The petition is **GRANTED**.

As provided in MPEP 204.06(c), this Office will not forward notice of this application's filing to the non-signing inventor at the addresses given in the petition, and notice of the filing of this application will not be repeated in the Official Gazette.

After this decision is mailed, the application will be forwarded to the Office of Initial Patent Examination for further processing.

Telephone inquiries regarding this decision should be directed to the undersigned at (703) 305-0011.



Paul Shanoski
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Office of Petitions
United States Patent and Trademark Office